Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte HERVE BAZIN and DOMINIQUE LATINNE

Appeal No. 2001-1746
Application No. 09/056,072

ON BRIEF

Before WINTERS, SCHEINER, and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

REQUEST FOR REHEARING

On December 22, 2003, an Order to Show Cause (Order) was entered into this administrative record. See Paper No. 22. The Order specifically required appellants to show cause why:

1. This Merits Panel should not deny a request for rehearing that fails to address an affirmed rejection that disposes of all appealed claims.[1]

2. A terminal disclaimer was not timely filed in this record.[2]

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[1] Cf. In re Kroekel, 803 F.2d 705, 709, 231 USPQ 640, 642-43 (Fed. Cir. 1986) (argument presented before the board after decision, but not in original Briefing, is not properly before the board).

[2] See In re Deters, 515 F.2d 1152, 1157, 185 USPQ 644, 648 (CCPA 1975) ("Since no terminal disclaimer was timely filed, we sustain ... [the obviousness-type double patenting] rejection."); Cf. In re Jursich, 410 F.2d 803, 807, 161 USPQ 675 (CCPA 1969), footnotes and citations omitted, ("The record shows that appellants' assignee filed a terminal disclaimer in the Patent Office after the board decision which the board refused to consider because it was not timely presented or considered by the examiner. Appellants assign error in that action by the board, arguing that the terminal disclaimer 'eliminated the double patenting issue in the present case.' However accurate that statement may be, we cannot consider the disclaimer here....").

To their single page response to the order to show cause (Response), appellants attach two terminal disclaimers that they believe "obviate the obviousness-type double patenting rejections with respect to U.S. Patent Nos. 5,730,979 and 5,951,983." According to appellants (Response), "by filing the terminal disclaimers, [appellants] have addressed the affirmed rejections that would have disposed of all claims." This response fails to address either of the specifically enumerated issues to which appellants were required to respond. See supra.

Regarding the first requirement of the Order, we find no explanation why appellants' Request for Reconsideration failed to state with particularity the points believed to have been misapprehended or overlooked with regard to our decision affirming, inter alia, the examiner's rejection of claims 30-44 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 18-19 of Bazin I, which disposed of all claims on appeal.

Regarding the second requirement of the Order, we find no explanation why the terminal disclaimers were not timely filed. For this reason, and for the reasons set forth in footnote 2 of the Order (see also n.2 herein) we do not consider the terminal disclaimers attached to appellants' Response to be timely filed.

We are unimpressed by appellants' approach to the issue of obviousness-type double patenting on this record. As set forth on page 14 of our Decision on Appeal (Paper No. 20), appellants fail to respond to the rejection of claims 30-44 under the judicially created doctrine of obvousness-type double patenting as being unpatentable

over claims 1-5 and 18-19 of Bazin I. Furthermore, with regard to the rejection of claims 30-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of Bazin II, appellants simply state that they "will consider the filing of a terminal disclaimer if the other rejections are reversed." Emphasis added.

Appellants fail to direct our attention to any authority that would support the proposition that a rejection under the judicially created doctrine of obviousness-type double patenting could be ignored, or could be accounted for after appeal. Cf. supra n.2. Even if appellants were under the mistaken belief that a rejection under the judicially created doctrine of obviousness-type double patenting could be held in abeyance and accounted for after appeal, they made no affirmative statement on this record prior to their Response that a terminal disclaimer would be filed. We find a world of difference between a statement that appellants "would consider the filing of a terminal disclaimer" (emphasis added) for one of two obviousness-type double patenting rejections, and an affirmative statement that terminal disclaimers will be filed after a favorable decision on appeal.

For the foregoing reasons, we find that appellants' Response is non-responsive to the Order. Having found that the terminal disclaimers attached to the Response were not timely filed, they will not be entered into the administrative record. Accordingly, appellants' request for rehearing is denied.

REQUEST FOR REHEARING - DENIED

Sherman D. Winters)
Administrative Patent Judge)
)
Toni R. Scheiner) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
Donald E. Adams)
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